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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Bernhard Lettmann

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EXAMINER

RAJGURU, UMAKANT K

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 11/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/018,336	LETTMANN, BERNHARD	
	Examiner	Art Unit	
	Umakant K. Rajguru	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 12, 13, 16, 29-32, 35 and 37-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 14, 15, 17-28, 33, 34 and 36 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: _____

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1, 11, 14, 15, 17-28, 33, 34 and 36, drawn to an aqueous coating, classified in class 524, subclass 474.
 - II. Claims 12, 13 and 29-32, drawn to a method applying, classified in class 427, subclass 391.
 - III. Claims 16, 35 and 37-41, drawn to an article, classified in class 428, subclass 371.

The inventions are distinct, each from the other because:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process as claimed can be practiced with another materially different product such as a lacquer.

Inventions I and II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as an ingredient to be incorporated in a molding compound and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant

should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Inventions II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make a materially different product such as foam.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

2. During a telephone conversation with Attorney Michael Morgan on October 1, 2003 a provisional election was made with traverse to prosecute the invention of I, claims 1-11, 14, 15, 17-28, 33, 34 and 36. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12, 13, 16, 29-32, 35 and 37-41 are

withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-5, 14, 15, 17, 18, 19 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite in reciting "substantially water-free." It is not precisely known how much free of water. Is it 80%, 90% or 99%?

Claim 1 is also indefinite in reciting "optionally water-soluble or water-dispersible." Is the binder soluble, not soluble, dispersible or not dispersible?

Similar remarks apply to claims 2-5 and 19.

Claim 14 is very vague because it is not clear what is precisely encompassed by scope of this claim.

Claims 15 and 36 are indefinite. It is not known what is "a color coating system" and "an effect coating system."

Claim 17 and 18 are indefinite. What is "(i) effect or (ii) color and effect"?

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11, 14, 15, 17-28, 33, 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reusmann et al (US 6403701) in view of Koruda (EP 1182513).

Reusmann describes a mixer system, which includes (A) many water-free base colors and (B) a pigment- free aqueous component (abstract). Component (A) contains less than 5% by wt of water, one coloring and/or special effect pigment, an organic solvent, a water thinnable or water-dispersible first binder and if desired auxiliaries and additive. Component (B) comprises an aqueous dispersion of polyurethane resin (column 2, line 60 to column 3, line 3). Components A and B read resp. on A1 and B of instant claims 1, 2 and 3. Rheology controlling additive is also added in the component B (column 10, line 63 to column 11, line 17). Polyurethane is one of the suitable binders (column 3, line 64 to column 4, line 20). The coating compositions can be applied by spraying on various substrates in multi-coats (column 13, line 43 to column 14, line 23).

Reusmann does not mention component A2 viz a composition comprising binder, pigment and water.


Koruda describes master batch pigment and a toner including master batch pigment (abstract). Master batch is prepared by mixing a dry pigment powder and a binder resin (paragraph [002]).


It would have been obvious to include the master batch of Koruda as a third component in the mixing system of Reusmann in order to produce desired color combination without the use of environmentally objectionable and hazardous solvent/s.

5. Any inquiry concerning this communication from the examiner should be directed to U.K. Rajguru whose telephone number is 703-308-3224. The examiner can generally be reached on Monday-Friday 9:30 am-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 703-308-2462. The fax phone numbers for the organization where this application is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-0661.


U.K. Rajguru/dh


SAMUEL A. ACQUAH
PRIMARY EXAMINER
GROUP 1700